

## **REMARKS**

The claims in the application are Claims 6,7,10, 11, 13-16, 23-26 and 28. Claims 1-5, 8, 9, 17-22 and 27 have been cancelled by previous amendment and Claims 12 and 29 have been cancelled by the above amendment.

## **AMENDMENT TO THE SPECIFICATION**

The priority of this application has been placed into the specification by amendment to page 1 of the present specification. The priority of this application was claimed upon the filing of this application as indicated by the filing receipt issued herein. The filing receipt is of record in this application establishing the right of the applicant to claim the earlier prior dates as noted in the amendment. In view of the record of this application applicant has the right to claim such earlier priority and the Examiner is respectfully requested to enter the amendment to the specification.

## **REJECTIONS UNDER 35 U.S.C.112, FIRST PARAGRAPH (NEW MATTER)**

The Examiner has rejected all of the claims for having the phrase “non-aromatic aminopolycarboxylate multidentate” in the independent claims 6 and 15. This rejection has been overcome by providing a clear, unambiguous meaning to the term by the addition of the Markush group setting out specific non-aromatic aminopolycarboxylate compounds. One of ordinary skill in the art need not refer to the specification to determine the meaning of the term “non-aromatic” in view of the above amendment. The Markush group now in the claims is fully supported by the specification and original claims.

Furthermore, it has been well decided that terms employed in the claims need not slavishly follow or necessarily correspond to words in the specification. In order to comply with the written description requirement in the first paragraph of 35 U.S.C. 112, first paragraph, the specification need not describe the claimed subject matter in exactly the same terms as used in the claims. The claims “must simply indicate to persons skilled in the art that as of the filing

date the applicant had invented what is now claimed.” See *Eiselstein v. Frank* 52 F3d 1035; 34 USPQ 2d 14657, 1470; (Fed. Cir 1995).

Accordingly, one of ordinary skill in the art to which the invention relates can easily identify the meaning of the claim, the breadth thereof and that the inventor possessed the claimed invention at the time the application was filed. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 112, first paragraph.

#### **REJECTION UNDER 35 U.S.C. 112, SECOND PARAGRAPH**

The Examiner has rejected all of the claims as being indefinite in the use of the phrase “non-aromatic aminopolycarboxylate multidentate”. This rejection has been overcome by the above amendment that gives full meaning to the term with unmistakable definition. By including the Markush group identifying the compounds it is now clear what is meant by the term “non-aromatic”. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 112, second paragraph.

#### **DOUBLE PATENTING REJECTION**

The Examiner has provided a nonstatutory double patenting rejection including all of the claims. The claims have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 8, 9, 11 and 13-17 of U.S. Patent 6,359,119. In the event of a finding of patentable subject matter in this application, a timely terminal disclaimer in compliance with 37 C.F.R. will be submitted.

#### **REJECTION UNDER 35 U.S.C. 103**

All of the claims in the application have been rejected under 35 U.S.C. 103(a) as being obvious in view of US Patent 6,359,119, to Pipes et al. (hereinafter referred to as “Pipes”) This rejection is respectfully traversed for the following reasons. As shown by the above amendment to the specification, this application has a priority date of June 29, 1999. Pipes was filed May 24, 2000. Accordingly, Pipes does not constitute adequate prior art under 35 U.S.C. 103(a).

Furthermore, Pipes does not teach or suggest the advantages of the present invention wherein the ligand is solely a multidentate. As is noted in the specification following the description of the aminopolycarboxylate ligands, the preferred ligands "are not bidentate". No appreciation for the advantages results obtained by the presently claimed invention is mentioned in Pipes. Accordingly, Pipes does not teach or suggest the present invention.

With respect to kits, it is important in this art, for the full commercial advantageous utility of radioactive materials to provide a kit whereby the half-life of the metal is taken into consideration. Each invention containing patentable subject matter should be given the benefit of providing a kit of the patentable invention. Accordingly, the claims to a kit referring to a patentable invention should also be allowed.

In view of the above amendment and remarks, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. 103(a).

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

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